

REMARKS

This paper is being presented in response to the non-final official action of September 3, 2003, wherein: (a) claims 1-25 are pending; (b) claims 5-12 and 22-25 have been withdrawn from consideration pursuant to a restriction requirement; (c) claims 1 and 17-21 have been rejected under 35 U.S.C. § 112, ¶ 1, as lacking an enabling disclosure; (d) claims 1-4 and 16-21 have been rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite; and, (e) claims 2-4 and 17-21 have been identified as containing allowable subject matter and "would be allowable if rewritten to overcome the § 112 rejections and to include all of the limitations of the base claim and any intervening claim(s)." Reconsideration and withdrawal of the rejections are respectfully requested in view of the foregoing amendments and following remarks.

This paper is timely filed as it is accompanied by a petition under 37 C.F.R. § 1.136(a) for an extension of time to file in the second month, and payment of the required extension fee.

A supplemental information disclosure statement was submitted on October 3, 2003. Consideration of that information disclosure statement and the documents identified therein and enclosed therewith are requested with the next action on the merits.

II. Brief Summary of the Amendments to the Claims

Independent claim 1 has been amended to incorporate the limitations of claim 2 and, accordingly, claim 2 has been canceled. Support for the amendment can be found in the specification at, for example, page 4, line 12 to page 5, line 7, wherein a formula of a heterocyclic amine is given. Dependent claim 3 has been amended to depend directly from independent claim 1 and to omit redundant recitations. Dependent claim 4 has been amended to correct typographical errors that appear in the first of the four agents recited as part of the Markush group. Specifically, the claim has been amended to change "imidao" to --imidazo-- and "(2H)" to --2(1H)--. In view of the amendment, the first of the four groups is now correctly recited in the claim as "(5R)-5-(methylamino)-5,6-dihydro-4H-imidazo[4,5,1-ij]quinolin-2(1H)-one." Support for the amendment can be found in the specification at, for example, page 6, lines 23-25, wherein the group is identified with its correct spelling and punctuation.

Withdrawn claims 5-12 and 22-25 have been canceled, without prejudice.

No new matter is introduced by the claim amendments.

III. The 35 U.S.C. § 112, ¶ 1, Rejections is Traversed

Claims 1 and 17-21 have been rejected under 35 U.S.C. § 112, ¶ 1, as lacking an enabling disclosure. Specifically, the action states that the specification is "enabling for a method of treating symptoms claimed using a heterocyclic amine of the formula I claimed (recited in claims 2-4)." See p. 3 of the action. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 1 has been amended to recite the heterocyclic amine of formula I as recited in claim 2, which the Patent Office acknowledges is enabled. Claims 17-21 which depend directly or indirectly from claim 1 also recite this limitation. Consequently, the scope of amended claim 1 and claims 17-21 is properly enabled under 35 U.S.C. § 112, ¶ 1.

IV. The 35 U.S.C. § 112, ¶ 2, Rejection is Traversed

Claims 1-4 and 16-21 have been rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. Specifically, the action states:

Where applicant acts as his or her own claim languages to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "psychoactive substance use disorders, inhalation disorders or intoxication disorders" in claim 1 is used by the claim to mean "disorders caused by psychoactive substance overuse, inhalation overuse or intoxication", while the accepted meaning is "disorders requiring psychoactive substance use, inhalation use or disorders causing intoxication, respectively." The term is indefinite because the specification does not clearly redefine the term.

See pp. 7 and 8 of the action. Reconsideration and withdrawal of the rejection are respectfully requested.

The applicants have *not* used these terms contrary to their ordinary meaning. For example, a "psychoactive substance use disorder" is meant to refer to a disorder caused by the use of a psychoactive substance. Furthermore, an intoxication disorder is meant to refer to a disorder resulting from intoxication. Still further, an "inhalation disorder" is meant to refer to a disorder resulting from inhalation of tobacco and/or other nicotine-containing products. In view of these readily-understood meanings and because the specification does not attempt to redefine these terms, claim 1 (and all claims dependent therefrom) are sufficiently definite such that the § 112, ¶ 2, rejection should be withdrawn. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing, cancellation of claims 2, 5-12, and 22-25, entry of the amendments to claims 1, 3, and 4, reconsideration and withdrawal of the rejections, and allowance of all pending claims 1, 3, 4, and 13-21 are respectfully requested.


Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is urged to contact the undersigned attorney.

Respectfully submitted,

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